

## **REMARKS**

### **SUMMARY:**

The subject application sets forth claims 1-50, of which claims 1, 16, 29 and 38 are independent claims.

Applicant notes with appreciation official indication that claims 5, 25, 35 and 41 have been indicated as containing allowable subject matter and would be allowed if rewritten in independent form to include all limitations of their respective base claim and any intervening claims.

The title of the invention has been objected to for not being descriptive. Claims 1, 3, 16-17, 21, 29, 38, 42 and 49 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-6, 8-12 and 14-15 stand rejected under 35 U.S.C. §102(a) as being anticipated by SA-Inc.com Web Pages (Solomon Associates, hereafter "SA"), dated January 2001. Claims 2-5, 13, 16-17, 19-29, 31-42 and 44-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the SA Web Pages as applied to claims 1, 6, 8-12 and 14-15 and further in view of Resolution Integration Solution, Inc.'s (RIS) systems and methods evidenced by various web pages referred to in the January 24, 2006 Office Action as References A, B, C and D, respectively. Claims 7, 18, 30 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over the SA Web Page reference and the four RIS web page references A-D, respectively, and further in view of U.S. Patent Publication No. 2004/0015271 (Juneau, Mark Anthony).

Responses to each of the rejections outlined above, including traversal of the prior art rejections, are presented below.

### **OBJECTION TO THE TITLE OF THE INVENTION:**

The title of the invention has been objected to for not being descriptive. A new title has been suggested by the Examiner. 37 C.F.R. §1.72 states that the title must be as short and specific as possible. It appears the Examiner believes that a slightly longer title, although sacrificing some amount of brevity, would advantageously provide more

informative value in indexing, classifying, searching, etc. As such, Applicant has provided an amended title to more specifically describe the claimed invention. A replacement title is provided in the Amendments to the Specification section of this response as a replacement section with markings to show changes relative to the original title. This amendment does not add any new matter and the new title does not exceed 500 characters. As such, Applicant respectfully requests that any objection to the title of the invention is overcome by the presently submitted amendments.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH:**

Claims 1, 3, 16-17, 21, 29, 38, 42 and 49 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the phrase “template” as used in such claims is alleged as being vague and indefinite.

Such ground of rejection is respectfully traversed. Applicant submits that the phrase “template” is clear and precise, even though other modes of expression may be available. Further, Applicant submits that breadth of the phrase template should not be equated with indefiniteness.

A fundamental principle contained in 35 U.S.C. § 112, second paragraph is that applicants are their own lexicographers. (See MPEP § 2173.01: Claim Terminology.) Since the phrase “template” is not used contrary to accepted meanings in the art, it is an appropriate term for defining embodiments of the subject invention. “Template” is a clear and precise term, which should be the focus for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph (see MPEP § 2173.02: Clarity and Precision). As evidence of this phrase’s clarity, Applicant notes that “template” is a term recognized in many dictionaries (both college-level and science/technical references), to generally indicate a guide or pattern for collecting information. It is also a term used in the prior art, specifically in the references cited by the Examiner in the January 24, 2006 Office Action. For example, page 2 of Reference D refers to report templates. Applicant also notes that the phrase “template” was included in a new title of the invention suggested by the Examiner on numbered page 2 of the January 24, 2006 Office Action. If the phrase “template” is suggested as appropriate for accurately

describing the claimed invention through the title of the invention, it is unclear to Applicant how such phrase can also be vague and indefinite.

Numbered page 3 of the January 24, 2006 Office Action also notes that “[a] template as claimed could include any of a plurality of entities including but not limited to formulas, equations, document formats, sets/catalogs of attributes/characteristics, models, worksheets, workbooks, standard processes/approaches, frameworks and the like”. This statement appears to indicate a problem with the phrase “template” as being too broad, and thus encompassing multiple more limited meanings such as those in the above list. Applicant respectfully submits that breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Just because “template” is a broad claim, it does not automatically follow that the phrase is indefinite. As indicated in § 2173.03 of the MPEP, since the scope of this claim is clear (although perhaps somewhat broad), then the claims comply with 35 U.S.C. §112, second paragraph.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 3, 16-17, 21, 29, 38, 42 and 49 under 35 U.S.C. § 112, second paragraph.

#### **BACKGROUND CASE LAW RE 35 U.S.C. §102 & §103:**

Before setting forth a discussion of the prior art applied in the Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under Sections 102 and 103.

"For a prior art reference to anticipate in terms of 35 U.S.C Section 102, every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed Cir, 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986). Anticipation under 35 U.S.C. Section 102 requires that there be an identity of

invention. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 635, 637 (Fed. Cir. 1985). In PTO proceedings, claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 U.S.P.Q. 385, 388 (Fed. Cir. 1983).

In addition to the well-known required multi-step analysis of Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966), and its progeny, the Court of Appeals for the Federal Circuit has on numerous occasions offered its guidance concerning the propriety of Section 103 rejections.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. (emphasis original)

ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.

Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987; footnotes omitted).

In In re Deminski, 230 U.S.P.Q. 313 (Fed. Cir. 1986), the court reversed a Patent Office Board of Appeals decision rejecting claims for obviousness, saying: "There [was] nothing in the prior art references, singly or in combination, 'to suggest the desirability, and thus the obviousness' of the [claimed subject matter]." Id. at 315; emphasis original. The court noted that the relied-on reference did not address the technical problem addressed by the claimed invention (and in fact taught away from the

Applicant's invention), and stated the well-established principle that "[h]indsight analysis is clearly improper...." Id. at 316.

In Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416 (Fed. Cir. 1986), the court vacated a district court holding of invalidity for obviousness. In doing so, the district court was criticized for viewing teachings from the prior art in isolation, instead of considering the prior art references in their entirety; for entering the tempting but forbidden zone of hindsight analysis; for failing to view the claimed invention as a whole; and for disregarding express claim limitations. Id. at 419, 420.

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

Bausch & Lomb, supra, at 419 (emphasis added).

The Supreme Court in Graham and Adams ... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts. [footnote omitted] Where the legal conclusion is not supported by facts, it cannot stand....

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art.... It [the Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.... [W]e may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness.

In re Warner, 379 F.2d 1011, \_\_, 154 U.S.P.Q. 173, 177, 178 (C.C.P.A. 1967; emphasis original).

"[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).

In addition, for example, in In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), a Section 103 rejection previously approved by the Board of Patent Appeals and Interferences was reversed by the Court of Appeals for the Federal Circuit. An apparatus claim recited, in essence, a means having a pumping capacity greater than an ingredient feed rate to a mixing chamber, while the reference disclosed a variable speed arrangement merely capable of the claimed operation but not expressly suggestive thereof.

While [the prior art] apparatus may be capable of being modified to run the way [applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so. [Citing authority] ... The apparatus claimed by [applicant] is different from that of [the prior art reference] ....

... It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure.

In re Mills, 16 U.S.P.Q.2d 1432, 1433.

"An analysis of obviousness of a claimed combination must include consideration of the results achieved by the combination. [Quoting authority] 'Critical to the analysis is an understanding of the particular results achieved by the new combination....'" The Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, \_\_, 16 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1990; affirming federal district court judgment holding claims not invalid).

The following analysis of the present rejections is respectfully offered with guidance from the foregoing controlling case law decisions.

**CLAIM REJECTIONS UNDER 35 U.S.C. §§ 102(a) and 103(a):**

Claims 1-6, 8-12 and 14-15 stand rejected under 35 U.S.C. §102(a) as being anticipated by SA-Inc.com Web Pages (Solomon Associates, hereafter "SA Web Pages"), dated January 2001. Claims 2-5, 13, 16-17, 19-29, 31-42 and 44-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the SA Web Pages as applied to claims 1, 6, 8-12 and 14-15 and further in view of Resolution Integration Solution, Inc.'s (RIS) systems and methods evidenced by various web pages referred to in the January 24, 2006 Office Action as References A, B, C and D, respectively

(hereafter, "RIS References"). Claims 7, 18, 30 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over the SA Web Pages and the RIS References and further in view of U.S. Patent Publication No. 2004/0015271 (Juneau). Such grounds of rejection are respectfully traversed based on the presently submitted amendments and the following remarks.

Before discussing the distinctions between the claimed invention and the technology disclosed in the SA Web Pages, Applicants request that the Examiner kindly provide more information about the date of availability of a portion of this reference. This 62-page reference cited by the Examiner in the January 24, 2006 Office Action is a collection of assembled Internet publications. It is clear from the website designation on the bottom of the first three pages (and the corresponding link to such information) that these pages were obtained from an archive of websites previously posted from Solomon Associates, Inc. on January 24, 2001. Similarly, pages 4-17 appear to have been retrieved from a website archive captured on February 9, 2001. However, the majority of the SA Web Pages reference (pages 18-62) corresponds to a document that does not appear to include a publication date (or retrieval date). Such pages are entitled "METHODOLOGY SECTION FROM THE 1999 STUDY REPORT"; however, Applicants note that 1999 is not the date of publication of such reference. 1999 is simply the operating year for which data was collected to conduct subsequent performance analyses within the olefin manufacturing industry. The study indicates that 1999 plant data was collected in 2000 (see bullets 3-5, page 19), and analysis and report presentations (from which this section summary is apparently derived) were not completed until later in 2000 and 2001 (see paragraph 2, page 18). From the information provided, the publication date of this study report section (pages 18-62 of the SA Web Pages reference) is not clear. In accordance with § 2128.01 of the MPEP, if the electronic publication does not include a publication date or retrieval date (neither of which are included on pages 18-62), then this reference cannot be relied on as prior art under 35 U.S.C. §102(a) or (b). As such, Applicant respectfully requests that more conclusive evidence of the date of availability of this reference be provided. Otherwise, this reference cannot be relied on as prior art.

The remainder of this response will address the entire SA Web Pages reference as being valid, although this should not be taken to waive the above challenge to the availability of pages 18-62 as a prior art reference.

Applicants note that numbered page 28 of the January 24, 2006 Office Action notes that the instant application appears to disclose patentable subject matter that is not recited in the claims. These aspects of the invention are directed to a method and system for dynamically creating resource utilization performance models for a plurality of facilities, wherein the models account for changes in a facilities' attributes over time and highlight opportunities to improve the facilities' resource utilization. Based on this indication and other understanding from a May 24, 2006 phone interview with the Examiner, Applicants currently present amendments to independent claims 1, 16, 29 and 38, respectively, that set forth various methods and apparatus for creating dynamic facility models.

Presently amended claims 1, 16, 29 and 38 variously set forth language directed to features that enable the facility models to account for changes in a facility's attributes over time. This is accomplished in part by an ability to define facility attribute data (and sometimes resource utilization data) relative to instances (denoted, for example as time spans X, X+1,...,X+n in the application - see particularly Figs. 4-5. and the corresponding discussion). As described in the specification, "instances" are defined by points in time when attribute data is either created or updated. As described in the Background of the Invention (see pg. 2, lines 11-18 of original application), this time representation and processing is distinguished from conventional data normalization practices, and helps provide more accurate facility modeling. Data that is normalized over defined instances of time when such data changes is more accurate because normalized resource utilization data then is not based on mere estimates of an attribute value over longer periods of time, but on actual dynamic data values as they change over time. (See also page 2, lines 19-34 of the original application.)

Presently amended claims 1, 16, 29 and 38 also variously set forth language directed to features that inherently provide an ability to highlight opportunities to improve a facilities' resource utilization (e.g., reduce resource consumption). One exemplary way this recognition can be accomplished is by providing reports that present the

normalized resource utilization data to a user. (See page 4, lines 5-9 of original application.) The reports will include the most accurate representation of resource utilization possible because the data incorporates attribute values as they dynamically change over time (instead of based on mere attribute estimates). This accurate information may then be viewed by one skilled in the art to inherently realize when resources could perhaps be utilized/consumed in more efficient ways. A report generation step has been incorporated into present claim 1, and was previously presented in claim 29. Another example of ways a user may highlight opportunities to improve a facilities' resource utilization is to compare selected resource utilization data so as to benchmark each facility based on such comparing. By benchmarking utilization data, a user has a standard of comparison with which improvements to resource utilization may be recognized. Such comparison step is presently added to claim 38, and was previously included in claims 16 and 29.

Applicant submits that the normalizing feature or aspect and either report generation or benchmarking feature or aspect recited in all four independent claims of the application produces a "useful, concrete, and tangible result." The normalized data is more useful because of its accuracy in modeling attribute changes over time, and provision of reports or benchmark comparisons yields concrete and tangible results for a user to determine how to improve or otherwise address resource consumption concerns for a given facility or facilities.

Applicant further submits that the above features of claims 1, 16, 29 and 38 are not disclosed singularly or in combination of the cited references. As such, these references cannot serve to anticipate such claims or otherwise render such claims unpatentable.

Based on the presently submitted amendments and above remarks, Applicants respectfully submit that claims 1, 16, 29 and 38 are in condition for patentability, and acknowledgement of the same is earnestly solicited. Further since claims 2-15, 17-28, 30-37 and 39-50 variously depend from such otherwise allowable independent claims and further limit same, such dependent claims should also be allowed.

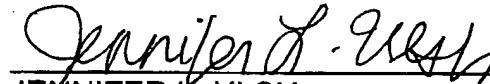
**CONCLUSION:**

In view of the foregoing, Applicant respectfully submits that the present application, including claims 1-50 thereof, fully complies with all requirements of 35 U.S.C. §112 and 35 U.S.C. §101, and clearly and patentably defines over the applied references, wherefore reconsideration and allowance of present claims 1-50 are respectfully requested.

Respectfully submitted,

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